



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/346,353	07/02/1999	MARIE ANGELOPOULOS	YO996-049BX	2281
7590 Thomas A. Beck Esq. 6136 West Kimberly Way Glendale, AZ 85308-7627				
02/02/2009				
EXAMINER				
YOON, TAE H				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
02/02/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/346,353

Applicant(s)

ANGELOPOULOS ET AL.

Examiner

Tae H. Yoon

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2008.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-7,9-11,14-16,20,22-25,40-42 and 47-56 is/are pending in the application.

4a) Of the above claim(s) 11 and 47-56 is/are withdrawn from consideration.

- 5) ☐ Claim(s) _____ is/are allowed.

- 6) ☒ Claim(s) 1,3-7,9,10,14-16,20,22-25 and 40-42 is/are rejected.

- 7) ☐ Claim(s) _____ is/are objected to.

- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.

- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some * c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)

Paper No(s)/Mail Date _____

- 5) ☐ ~~Notes of Informal Patent Application~~

- 6) ☐ Other: _____

Again, note that the claimed language is not needed for the cancelled claim. For example, "Claim 2 (cancelled)" is sufficient **without a body of the language for the cancelled claim** as in claim 8.

Claim status identifier (Currently Amended) in claims 16, 25 and 42 is confusing and incorrect since no amendment is recited in claims. Also, claim 11 is improper amendment since an underline for newly recited limitation (said additive is 5% by weight poly-co-dimethyl propylamine siloxane) is missing.

Amended claim 11 with poly-co-dimethyl propylamine siloxane as an additive (introduced in amendment filed on July 11, 2007 which is currently pending after non-final rejection of December 13, 2006) and claims 47-56 (previously submitted) are directed to an invention that is non-elected. See the page 2 of the office action mailed on May 4, 2000 in which the **election** of a plasticizer for the additive is stated. Original claims do not recite said poly-co-dimethyl propylamine siloxane as an additive, and said plasticizers would be limited to species of the original claim 4 which are taught by Han. Thus, unusual or particular plasticizer such as poly-co-dimethyl propylamine siloxane would have been restricted it presented earlier by way of election of species. **Use of siloxane was patented in the parent case as US Pat. 5,969,024.**

Note that this is a RCE drawn to the examined claims.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, **claims 11 and 47-56 are withdrawn** from

consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 3-6, 15, 16, 20 and 23-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

This is NEW MATTER rejection since the recited “conjugated **diene** polymer” does not have support in the originally filed specification. Contrary to applicant’s statement, **a diene polymer (elastomer or rubber) is not disclosed.**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7, 9, 10, 14, 25 and 40-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recited “conjugated polymer polymer(s)” in lines 5 and 11 of claim 7 lacks antecedent basis and thus it is confusing and indefinite.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-7, 9, 10, 14-16, 20, 22-25 and 40-42 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Han (US 5,171,478).

Rejection is maintained for reason of record and following.

Claim 11 has been withdrawn from consideration as reason given above.

Applicant's argument based on the poly-co-dimethyl propylaniline siloxane in said claim has no probative value since the examined and elected additive is a plasticizer of the original claim 4, not said poly-co-dimethyl propylaniline siloxane. Applicant failed to further traverse the rejection of above claims. Han further teaches dopants at col. 20.

Claims 1, 3-7, 9, 10, 14-16, 20, 22-25 and 40-42 are rejected under 35 U.S.C. 103(a) as obvious over Han (US 5,171,478) in view of Cao et al (US 5,232,631).

Rejection is maintained for reason of record and following.

Applicant asserts that example 6 of Han shows that powder is suspended in the NMP which is different from applicant's invention which uses only NMP as the solvent to put the polymer into solution. However, such assertion is incorrect since claim 1 does not recite a step of dissolving a polymer such as polyaniline in a solvent such as NMP contrary to applicant's assertion. Rather, the instant claim 1 recites "polymer being soluble in said solvent" which is different from "polymer is dissolved in said solvent". Said solubility would be dependent on a concentration which is not recited either. The instant claim 7 recites mixing of all components in obtaining a solution and also recites "comprising" which permits other components and steps.

The instant invention and Han (example 6) teach use of the same polymer (polyaniline) and the same solvent (NMP). Thus, Han would meet the claim 1.

Cao et al is recited to show that stretching of a film is well known practice in the art. Again, stretching of film of Han in order to obtain an oriented film is an obvious practice as taught by Cao et al.

Claims 7, 9, 14, 25 and 40-42 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Elsenbaumer (US 4,983,322).

Rejection is maintained for reason of record with following response.
Contrary to applicant's assertion, the instant claims do not recite any particular dopant.

Note that the use of inherency is proper when a combination of 102(b)/103(a) is used. Furthermore, the art of record teaches the same solution process utilizing the same polymer, solvent and additive, and thus the final product would have the same properties and morphology and applicant failed to show otherwise.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (571) 272-1128. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Tae H Yoon/
Primary Examiner
Art Unit 1796

THY/January 28, 2009